

## REMARKS

### Summary

Claims 1-28 were pending. All of the claims were rejected in the Office action. The Applicant has amended Claims 1-2. Claims 1-28 remain pending. No new matter has been introduced. The Applicant has carefully considered the Examiner's reasons for rejection of the claims and in view of this amendment and the remarks presented below, respectfully traverses the rejection of the pending claims.

### Rejection of Claims

Claims 1, 19-25 and 27 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kurita (US 5,353,016; "Kurita"). Claims 2-4 and 6-17 were rejected as unpatentable under 35 U.S.C. § 103(a) over Kurita in view of Madill et al (US Des. 363932; "Madill"). Claims 5 and 18 were rejected under 35 U.S.C. § 103(a) over Kurita in view of Funado (US 5,537,107; "Funado").

### Rejections under U.S.C. § 102(b)

Claims 1 and 20 were rejected as being anticipated by Kurita.

"[A]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears Roebuck & Co. 722 F.2d 1542 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Amended Claim 1 recites a display member being overlaid on the input mechanism. Claim 20 recites a removable display sheet disposed in the case, the display panel overlaid on the input mechanism.

To the contrary, Kurita teaches that the operating card is disposed beneath a transparent plate-like coordinate input means, not above the input mechanism as recited in Claims 1 and 20. The Examiner recognized an advantage of the arrangement

taught and claimed by the Applicants in that the display member can serve to protect the input mechanism from damage. That such an advantage is seen in hindsight in view of Applicants' teaching should not be used to read a suggestion to adopt the arrangement of Claims 1 and 20 into the teachings of a reference. Claim 19 is dependent on Claim 1, and Claims 21-25 and 27 are claims dependent on Claim 20; as these claims are dependent on an allowable claim, and further limit the subject matter claimed, they are likewise allowable. In addressing rejections under 35 U.S.C. § 103(a) below, the Applicants also demonstrate that the arrangement of Claim 20 and amended Claim 1 are not obvious variants of Kurita.

**Rejections under 35 U.S.C. § 103(a)**

The Examiner contends that there is no functional difference between a display member which is overlaid on the input mechanism as recited in amended Claim 1 and one which is beneath the transparent plate-like coordinate input means of Kurita. Applicant respectfully disagrees as numerous functional differences are evident. For example, in the arrangement of Applicants' amended Claim 1, where the display member is overlaid on the input mechanism, the display member may be deformed such that it touches the planar input device, or at least deformed sufficiently to change a sensed parameter, in order for data to be input. In the configuration taught by Kurita however, where the transparent plate-like input means lies above the operating card, pressure or contact is applied to the transparent plate-like coordinate input means, which need not deform in order for the input to be sensed. Hence, there is a functional difference between the arrangement of Claim 1 and the teachings of Kurita for the interaction mechanism between the operator and the controller. Therefore, Kurita does not teach every element in Claims 1 and there is no suggestion in the cited reference to adopt the arrangement of Applicants' claims.

Additionally, the teachings of Madill are cited. Madill is a design patent and one must base the teaching on what can be observed or inferred from the drawings. The Examiner interprets Madill to teach pressure sensitive buttons, which are not a feature of the arrangement in Applicants' amended Claim 1. Further, Fig. 1 of Madill illustrates

an overlay card with cutouts so that the pressure sensitive buttons can protrude above the surface of the overlay card and be directly pressed by the operator. It is not planar; the sensing buttons project above the overlay. This is entirely different from both Kurita where the operating card is beneath the transparent plate-like input means and from the arrangement of amended Claim 1 where the display member is disposed above the input mechanism. The arrangement in Madill does not provide flexibility in layout of the input areas for different applications, being constrained by the physical position and appearance of the buttons. Madill does not teach that the overlay have any mechanism so that the remainder of the controller could sense that a different overlay has been installed. In fact there is no suggestion in Madill that the design is intended to encompass more than one overlay card in its application. Commonly such overlays are fixed in place with an adhesive. There is thus no motivation in either reference to combine the teachings of Kurita and Madill.

Since Kurita does not teach all elements of amended Claim 1, and Madill does not teach or suggest a display mechanism located above the input mechanism, nor is there any suggestion to try the configuration of amended Claim 1, a *prima facie* case of obviousness has not been made and the Applicants respectfully submit that Claim 1 is allowable. Claims 2-19 are dependent on amended Claim 1, and are thus also allowable.

Claims 5 and 18 were rejected over Kurita in view of Funado. Claims 5 and 18 depend on Claim 1, which Applicants submit is allowable. Claims further limiting an otherwise allowable independent claim are allowable *per se*. Additionally, neither Kurita nor Funado, alone or in combination, teaches or suggests the combination recited in Claim 5 and 18. Applicants' Claim 5 recites a display panel (LCD in Claim 18) whose contents are switched by the operation member in response to, *inter alia*, a switching signal supplied from the host device. It is clear from Fig. 1 of Funado and column 2 line 46-47, that the display arising from actions by the host device is a video image. The CPU can generate character data and the character data may be superimposed on the video data, but operator input to the controller is through a separate key pad (column 2, line 55-57) whose operation is entirely distinct from the LCD display. Pressing on the

LCD display will not result in any input by the operator to the controller. Therefore the cited references do not teach or suggest the arrangement in Claims 5 and 18. Since a *prima facie* case of obviousness has not been made, the Applicants respectfully submit that these claims are allowable.

**Conclusion**

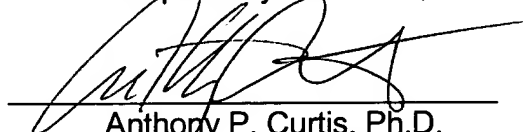
Claims 1-28 were pending. Claims 1 and 2 have been rewritten. Claims 1-28 are now pending.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is Appendix A.

In view of the arguments presented and the claim amendments made in this response, Applicants respectfully submit that the application is in a condition for allowance and request that a notice of allowance issue.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,



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Appendix A

VERSION WITH MARKINGS TO SHOW CHANGES MADE

CLAIM AMENDMENTS

1. (Amended) A controller which enables wireless communication between an operation member and a host, said operation member comprising:

a transmission mechanism;

an input mechanism;

a display member that displays an input portion of said input mechanism, the input portion including input items, display of one of the input portion and at least one input item being changeable, said display member being overlaid on said input mechanism; and

a control section that generates a transmission signal corresponding to said display of said display member when said input mechanism is operated.

2. (Amended) A controller according to Claim 1, wherein said input mechanism is a planar input device to which a coordinate position can be input, ~~and said display member is overlaid on said planar input device.~~